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RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
GROUP 1617
PATENT APPLICATION
Q48500

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Masao INOUE, et al.

Appln. No.: 08/987,380

Confirmation No.: not yet assigned

Group Art Unit: 1617

Filed: December 9, 1997

Examiner: S. Wang

For: GRANULAR PESTICIDAL COMPOSITION

REQUEST FOR RECONSIDERATION

ATTN: BOX AF

Commissioner for Patents

Washington, D.C. 20231

Sir:

This Request for Reconsideration is submitted in response to the Office Action dated March 6, 2001, in which the Examiner set a three-month period for response.

A Petition for Extension of Time for three months is attached hereto and incorporated herein by reference, extending the time for response from June 6, 2001 to September 6, 2001.

Claims 1-3, 5-7, 10, 11, and 13 are all the claims pending in the application.

Initially, Applicants note that the present Action was made final on the basis that Applicants' Amendment filed August 1, 2001, necessitated the new grounds of rejection presented in the Office Action. However, Applicants respectfully request the Examiner to reconsider whether the Amendment filed August 1, 2001, actually necessitated the new grounds of rejection presented in the Office Action since the

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subject matter of the amendments made to claim 6 were present in original claims 6 and 9. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the finality of the Action.

I. Response to rejection of claims 1-3, 5-7, 10, 11 and 13 under 35 U.S.C. § 103

On pages 2-4 of the Office Action, the Examiner rejects claims 1-3, 5-7, 10-11 and 13 as allegedly being unpatentable over Tocker (WO 91/10362 of record) in view of Burger et al. (Derwent Abstract, Derwent-ACC-No. 1993-067839).

Applicants respectfully traverse this rejection for the following reasons.

The Examiner acknowledges that Tocker does not teach the employment of the particular procedure for making the coating wherein the polyols and polyisocyanate are mixed before the application to the granules. However, the Examiner cites Burger et al. as teaching that mixing the polyol and polyisocyanate before applying them to the granules is known for coating agrochemical granules for forming multiple layers of polyurethane coating. Therefore, the Examiner takes the position that it would have been obvious to a person of ordinary skill in the art to modify the pesticidal granules of Tocker by mixing the polyols and polyisocyanates first followed by coating the mixture to the granules.

Tocker discloses a simplified process for preparing controlled release granules of pesticides for direct application consisting essentially of overcoating a granular carrier containing a pesticide and a polyhydroxylated compound or water with a liquid polyisocyanate and a polymerization catalyst. Because the polyhydroxylated compound is contained in the granular carrier, polymerization of the polyhydroxylated

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compound and the polyisocyanate is conducted on the surface of the granular carrier. (i.e. interfacial polymerization is conducted). Therefore, it is essential in the invention of Tocker that the polyhydroxylated compound is contained in the granular carrier and that the interfacial polymerization is conducted with the granular.

Burger discloses a process for manufacturing membrane-covered fertilizer granules by coating the granules with films of a mixture of a polyisocyanate and a polyol. The coating compound is applied in proportions so that each film has a thickness of 10 to 30 μ m, preferably 15 to 20 μ m. The granular fertilizer manufactured in this way has the advantage that it initially emphasizes nitrogen release and subsequently potassium release.

Applicants respectfully submit that since Tocker is directed to a pesticide and Burger is directed to fertilizer, a person of ordinary skill in the art would not be motivated to combine the references to achieve the present invention, because the references are directed to different objectives.

In addition, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. *See MPEP 2143.* An important characteristic of Tocker's invention is in the process, which is an essential part of the invention. Therefore, a person of ordinary skill in the art would not modify the process of Tocker without strong motivation to do so. Such strong motivation has not been established since the process of Tocker provides a controlled release of pesticides. Specifically, there is no reason for a person of ordinary skill in the art to be motivated to modify

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Tocker because Tocker is complete and functional in itself. Accordingly, a person of ordinary skill in the art would by modify Tocker to arrive at the present invention.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Since neither Tocker nor Burger provides any desirability of the combination, motivation for a person of ordinary skill in the art to combine the references is absent, and therefore the present invention would not be achieved.

Regarding claims 5, 7, 10, 11, and 13, which recite water absorption ratio of the polyurethane is not more than 5%, the Examiner states that "the polyurethane coating of Tocker is reasonably expected to have the same water absorption ratio as claimed herein." However, Tocker does not teach or suggest an absorption ratio of polyurethane.

As described in the present specification, the inventors of the present invention found that it was preferable to select a resin having low water absorption ratio (preferably not more than 5%) to obtain high crosslinking degree of resin. The composition coated with a resin having a water absorption ratio of not more than 5% releases the pesticidal active ingredient for longer period. See Table 2 of the present specification. Tocker does not teach or suggest such finding at all. Therefore, Tocker fails to teach or suggest the present invention.

In view of the above, Applicants respectfully request that the rejection be withdrawn.

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II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,


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